

**REMARKS****I. Introduction**

Claims **1-7, 12-43, 47-59, 61-72, 74-79, 82-104, and 108-126** are currently pending in the present application. Claims **1-2, 13, 15, 17, 19, 22, 28, 30, 33, 35, 47-48, 74, 108, 119, and 123-126** are independent. Claim **90** is objected to and all pending claims stand rejected. In particular:

(A) all pending claims (claims **1-7, 12-43, 47-59, 61-72, 74-79, 82-104, and 108-126**) stand rejected under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the written description requirement;

(B) all pending claims (claims **1-7, 12-43, 47-59, 61-72, 74-79, 82-104, and 108-126**) stand rejected under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the enablement requirement;

(C) all pending claims (claims **1-7, 12-43, 47-59, 61-72, 74-79, 82-104, and 108-126**) stand rejected under 35 U.S.C. §112, second paragraph, for allegedly being indefinite;

(D) all pending claims (claims **1-7, 12-43, 47-59, 61-72, 74-79, 82-104, and 108-126**) stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 5,897,622 (hereinafter "Blinn");

(E) claims **16-17 and 34-35** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Blinn in view of U.S. Patent No. 6,820,062 (hereinafter "Gupta");

(F) claims **55-56, 69-72, 114, and 118** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Blinn in view of an article entitled "Web Ordering May Alter Role of Distributors", published June 22, 1998 (hereinafter "Tice"); and

(G) claims **119-126** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Blinn in view of U.S. Patent No. 5,918,213 (hereinafter "Bernard").

Upon entry of this amendment, which is respectfully requested, claim **90** will be amended for reasons unrelated to any art of record (*e.g.*, *solely* to advance prosecution with respect to the §112 grounds for rejection). No new matter is believed to be introduced by this amendment.

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the amendments and remarks provided herein and in accordance with 37 C.F.R. §1.114.

## **II. Priority**

Applicants respectfully note that the Examiner's statement "inventor Fincham does not appear in other patent applications" (Final Office Action, pg. 13, lines 9-10) is both irrelevant and incorrect. A quick search for inventor Magdalena M. Fincham via the Office's website reveals forty-seven (47) issued patents and one hundred and eighty-one (181) published patent applications for which such inventor appears to be named. Applicants accordingly assume that the Examiner *intended* to allege that inventor Fincham is not a named inventor on any patents and/or patent applications to which the present case claims benefit and priority. As the present case only appears to claim benefit and priority to U.S. Patent Application Serial No. 09/085,424, which issued as U.S. Patent No. 6,138,105 on October 24, 2000 (such claim of priority having been made in an amendment submitted on May 17, 2002; hereinafter the "Walker Parent"), and the Walker Parent does not name inventor Fincham, the allegation *assumed* to have been intended by the Examiner appears to be entirely correct.

Applicants also respectfully note that the Examiner's allegation that "profit margins...are not mentioned in any of the applications upon which applicant relies for priority" (*Id.*, lines 13-14) is incorrect, twofold. First, the present case only appears to claim benefit and priority to the Walker Parent, which is a *single* application, not "applications" in the plural. Second, profit margins are clearly profitability metrics. The utilization of "product profitability" in structuring package deals is explicitly introduced in the Walker Parent at Col. 10, lines 56-65. As the Examiner provides no evidence or argument that any other currently-claimed concept lacks support in the Walker Parent, Applicants respectfully assert that all pending claims should be afforded a priority date of at least May 27, 1998 (the filing date of the Walker Parent).

### III. The Examiner's Responses to Applicants' Arguments

Applicants greatly appreciate the Examiner taking the time and effort to provide over ten (10) pages of responses to Applicants' arguments presented in the previously submitted response. Applicants also greatly appreciate the Examiner providing a chart to assist in categorizing the many pending claims. Applicants respectfully address the Examiner's responses with respect to their respective grounds for rejection addressed separately herein.

### IV. The Examiner's Objection

The Examiner objects to claim **90** for having an informality. Applicants thank the Examiner for identifying the typographical error which Applicants correct via amendment herein. In light of the amendment to claim **90** submitted herein, Applicants respectfully request that this ground for objection to claim **90** be **withdrawn**.

### V. The Examiner's Rejections

#### A. 35 U.S.C. §112, first paragraph – Written Description

All pending claims (claims **1-7, 12-43, 47-59, 61-72, 74-79, 82-104, and 108-126**) stand rejected under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the written description requirement. Applicants traverse this ground for rejection as follows.

#### 1. Presumption of Adequate Written Description

Applicants initially and respectfully note that a **“description as filed is presumed to be adequate**, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971).” MPEP §2163 III.A.; emphasis added. In fact, “[t]here is a **strong presumption** that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976).” MPEP §2163 I.A.; emphasis added.

Accordingly, “[t]he examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97.” MPEP §2163 III.A.; emphasis added.

In rejecting a claim, **the examiner must set forth express findings of fact** regarding the above analysis which support the lack of written description conclusion. These findings should:

- (A) Identify the claim limitation at issue; and
  - (B) Establish a prima facie case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of “unpredictability in the art” is not a sufficient reason to support a rejection for lack of adequate written description.
- MPEP §2163 III.A.; emphasis added.

## **2. Detail of Well-Known Terms Not Required**

Applicants also respectfully note that “[t]he absence of definitions or details for well-established terms or procedures should not be the basis of a rejection under 35 U.S.C. 112, para. 1, for lack of adequate written description.” MPEP §2163 II.A.1. “Information which is well known in the art need not be described in detail in the specification. See, e.g., *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379-80, 231 USPQ 81, 90 (Fed. Cir. 1986).” MPEP §2163 II.A.2. Indeed, “[i]f a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g., *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating “the description need not be in *ipsis verbis* [i.e., “in the same words”] to be sufficient”).” MPEP §2163 II.A.3.(a).

## **3. Required Factual Determinations**

Applicants further respectfully note that determination of “[w]hether the specification shows that applicant was in possession of the claimed invention is not a

single, simple determination, but rather **is a factual determination reached by considering a number of factors.**” MPEP §2163 II.A.3.(a).(i).; emphasis added.

The factors outlined in MPEP §2163 as being necessary to consider in formulation of a *prima facie* case of lack of written description include:

1. level of skill and knowledge in the art;
2. partial structure;
3. physical and/or chemical properties;
4. functional characteristics alone or coupled with a known or disclosed correlation between structure and function; and
5. the method of making the claimed invention.

#### 4. The Examiner’s Case as Set Forth

The Examiner states, that:

[t]he claims include [sic] limitation...dynamically determining a package on an ad-hoc basis...wherein at least one secondary product does not have a pre-established relationship with a primary product... The specifications [sic] do not describe the combination as a single embodiment, as all products are related via the database.

Final Office Action, pg. 14, second paragraph; emphasis in original.

The Examiner elaborates, in the Examiner’s Response to Applicants’ previous arguments, that:

[i]t is not clear whether Applicant [sic] claims [sic] patentable distinction by his [sic] use of the hyphen, e.g., pre-determined v. predetermined and pre-established v. pre established. Applicant [sic] does not provide description of [sic] patentable distinction. Applicants’ latest comments add to the confusion, since products are selected for inclusion in the package based on profit margin considerations and does [sic] not describe how profit margins have nothing to do with the relationship of the primary and secondary products in a package.

Final Office Action, pg. 3, second paragraph from the bottom, to pg. 5, first paragraph.

## 5. The Examiner Has Failed to Set Forth a *Prima Facie* Case

Applicants note that the Examiner has failed to set forth *any* evidence supporting the conclusion **that one of ordinary skill in the art would not have understood the inventor to be in possession of the claimed invention at the time of filing**. Nor has the Examiner provided any findings regarding the factors required by MPEP §2163.

Applicants respectfully note that the Examiner appears quite confused with respect to the concept of the primary and secondary products not having a predetermined relationship (regardless of hyphenation). Indeed, the Examiner appears to allege that because information regarding both the primary and secondary products is stored in a database, it is related. The Examiner also appears to allege that because profit margin data for each product is stored in the database, that the products are “related”. Applicants respectfully note that such an interpretation of the term “related” is simply untenable.

Databases do indeed often “relate” sets of data, and both Applicants’ specification, as well as Blinn, describe various uses of databases to relate different products. Much data that resides in databases, however, is “unrelated”. Two separate rows of data in a database (e.g., a first row descriptive of a primary product and a second row descriptive of a secondary product), unless explicitly “related” via a field such as a primary or secondary key, are not “related”. One of ordinary skill in the database arts would have understood this basic premise at the time of invention.

Further, contrary to the Examiner’s assertion that *Applicants* must prove that profit margins do not “relate” products in a predetermined manner, Applicants respectfully note that it is *the Examiner* that must provide evidence that profit margins “relate” products in a predetermined manner. On its face, an assertion that profit margins “relate” products in a predetermined manner appears deeply erroneous. One of ordinary skill would not have viewed profit margins as establishing a “predetermined relationship” between products. Accordingly, the Examiner’s contention that Applicants’ specification lacks written description of a misinterpretation of a simple database concept, is simply and entirely misplaced.

Applicants also note that the Examiner’s consternation regarding whether a hyphen is utilized in various terms is entirely irrelevant. Nor do Applicants have any reasonable idea regarding what the Examiner intends to assert when alleging that

Applicants have not described a “patentable distinction”. Applicants are unaware of any requirement in §112, first paragraph regarding whether a “patentable distinction” has been described or not. Instead, the written description requirement of §112, first paragraph requires **that one of ordinary skill in the art would have understood the inventor to be in possession of the claimed invention at the time of filing**. In this case, the Examiner has provided absolutely no evidence that one of ordinary skill would have had any problem understanding that the embodiments as currently claimed were in the possession of Applicants at the time of invention.

At least for these reasons, the Examiner has simply and entirely failed to establish a *prima facie* case for lack of written description, and this §112, first paragraph ground for rejection should therefore be **withdrawn** with respect to all pending claims (claims **1-7, 12-43, 47-59, 61-72, 74-79, 82-104, and 108-126**).

**B. 35 U.S.C. §112, first paragraph – Enablement**

All pending claims (claims **1-7, 12-43, 47-59, 61-72, 74-79, 82-104, and 108-126**) stand rejected under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the enablement requirement. Applicants traverse this ground for rejection as follows.

**1. Test of Enablement – MPEP §2164.01**

The test for enablement under 35 U.S.C. §112, first paragraph, is set forth as follows:

The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)...The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976).

MPEP §2164.01.

Determining whether the experimentation needed to practice the invention is undue requires an analysis of various factors, described as follows:

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

*In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)...

It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. 858 F.2d at 737, 740, 8 USPQ2d at 1404, 1407.

MPEP §2164.01(a).

## 2. *Prima Facie Case of Non-Enablement*

"In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure)". MPEP §2164.04; emphasis added.

The nature of the arguments and evidence required for the Examiner to meet this initial burden are described as follows:

According to *In re Bowen*, 492 F.2d 859, 862-63, 181 USPQ 48, 51 (CCPA 1974), the minimal requirement is for the examiner to give reasons for the uncertainty of the enablement...The language should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by



the claims. This can be done by making specific findings of fact, supported by the evidence, and then drawing conclusions based on these findings of fact.

MPEP §2164.04

### 3. The Examiner's Case as Set Forth

The Examiner states, that:

[t]he claims include [sic] limitation...*dynamically determining a package on an ad-hoc basis*...wherein at least one secondary product does not have a *pre-established* relationship with a primary product... The specifications [sic] do not describe the combination as a single embodiment, as all products are related via the database.

Final Office Action, pg. 14, second paragraph; emphasis in original.

The Examiner elaborates, in the Examiner's Response to Applicants' previous arguments, that:

[i]n the instant case, Applicant [sic] has not persuasively demonstrated that the Examiner has applied an unreasonable interpretation of the recited feature, that the interpretation is inconsistent with the specification, or that [sic] applied interpretation is *repugnant* to one of ordinary skill in the art.

Final Office Action, pg. 5, first paragraph; emphasis in original.

### 4. No *Prima Facie* Case for Non-Enablement

Initially, it is unclear, based on the above-quoted assertions of the Examiner, how the Examiner believes **undue experimentation** would be required to practice the embodiments as claimed. It is not clear, for example, how the Examiner believes that the specification is devoid of sufficient enablement for *not* relating data stored in a database. Indeed, the Examiner has not satisfied the minimum required threshold for supporting a *prima facie* case of non-enablement, as the Examiner has failed to address or consider any (much less all) of the *In re Wand* factors quoted herein.

Nor is it clear how the Examiner's misinterpretation of the "recited feature" (see, Section V.A.5 herein) has anything to do with whether undue experimentation would be required to implement the claimed embodiments. The Examiner has provided no evidence that one of ordinary skill in the arts would have had any difficulty (much less

undue difficulty) implementing the claimed embodiments. The Examiner's assertion that the *Examiner* would have difficulty understanding how to implement the claimed embodiments sheds no light on the issues relevant to this ground for rejection (e.g., it is clear from the Examiner's deep confusion that the Examiner is not one of ordinary skill in the art).

At least for these reasons, Applicants hereby respectfully request that the §112, first paragraph, lack of enablement rejections of all pending claims (claims **1-7, 12-43, 47-59, 61-72, 74-79, 82-104, and 108-126**) be **withdrawn**.

**C. 35 U.S.C. §112, second paragraph – Indefiniteness**

All pending claims (claims **1-7, 12-43, 47-59, 61-72, 74-79, 82-104, and 108-126**) stand rejected under 35 U.S.C. §112, second paragraph, for allegedly being indefinite. Applicants traverse this ground for rejection as follows.

Applicants respectfully note that the Examiner's apparent and deep-seeded confusion with respect to how databases are structured and function is also responsible for the Examiner's confusion regarding the metes and bounds of the pending claims. Applicants respectfully assert that one of ordinary skill in *any* computer arts would be in full comprehension of the claimed subject matter.

Applicants have absolutely no comprehension regarding what the Examiner attempts to convey the several times that the Examiner respectfully notes that "examples are not definitions." Final Office Action, pgs. 4-5. Applicants have pointed to portions of the specification that provide examples of how the claimed embodiments function, yet the Examiner appears unimpressed and unmoved by such learning aids provided by Applicants. There is simply no requirement that every term utilized in a claim must be explicitly defined. Many terms or concepts are generally either well known, easily understood by one of ordinary skill, or *readily apparent based on examples provided in the specification*.

In this case, the pending claims are quite simply and generally directed to the concept of offering a package where the two package products are not "related" prior to

the offering. Applicants cannot comprehend how such a simple limitation could escape understanding.

Applicants also respectfully note that Applicants have *not*, contrary to the Examiners assertion, “admitted” that the claimed primary and secondary products are “related” in a predetermined manner by profit margin considerations. Neither the pending claims nor the specification require a predetermined relationship based on profit margins, nor do the pending claims require that there be any relationship between the first and second products (other than being offered in the same package – which occurs “dynamically”, and is accordingly not “predetermined”).

At least for these reasons, Applicants hereby respectfully request that the §112, second paragraph, indefiniteness rejections of all pending claims (claims 1-7, 12-43, 47-59, 61-72, 74-79, 82-104, and 108-126) be **withdrawn**.

**D. 35 U.S.C. §103(a) Rejections – Blinn**

All pending claims (claims 1-7, 12-43, 47-59, 61-72, 74-79, 82-104, and 108-126) stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Blinn. Applicants respectfully traverse this ground for rejection as follows.

**1. No *Prima Facie* Case of Obviousness**

The Examiner has failed to show how every element of the claims is taught or suggested by the cited reference and the Examiner has entirely failed to address or consider (much less resolve) any of the requisite factual inquiries as set forth in *Graham v. John Deere*. The Examiner has further failed to set forth a valid reason that would have led one of ordinary skill in the art to modify the cited reference as suggested by the Examiner. At least for these reasons, as described in more detail hereinafter, the Examiner has failed to establish a *prima facie* case for obviousness.

**a) The reference fails to teach or suggest: *dynamically determining a package on an ad hoc basis to be offered to the***

*customer, the package comprising the primary product and at least one secondary product...wherein at least one of the at least one secondary product is selected for inclusion in the package based on an indication of past interest, by the customer, in at least one secondary product, and further wherein the at least one secondary product does not have a pre-established relationship with the primary product*

Applicants respectfully assert that Blinn fails to teach or suggest limitations of claims **1-7, 12-43, 47-59, 61-72, 74-79, 82-104, and 108-126**. For example, Blinn fails to teach or suggest *dynamically determining a package on an ad hoc basis to be offered to the customer, the package comprising the primary product and at least one secondary product...wherein at least one of the at least one secondary product is selected for inclusion in the package based on an indication of past interest, by the customer, in at least one secondary product, and further wherein the at least one secondary product does not have a pre-established relationship with the primary product*.

The Examiner cites Col. 1, lines 43-56 of Blinn as allegedly teaching or suggesting the *wherein at least one of the at least one secondary product is selected for inclusion in the package based on an indication of past interest* portion of the above-quoted limitation. Final Office Action, pg. 18, third and fourth paragraphs. Applicants have reviewed this cited portion of Blinn and are entirely at a loss as to how any reasonable equation could be made between the clear description of simple frequent shopper club that provides discounts based on shopping frequency and the claimed offering products based on customers' past interest.

Simply nowhere does Blinn appear to contemplate (much less provide actual written description of) tracking or storing customers' past interest in products, much less offering a secondary product based on such data.

The Examiner further cites FIG. 13B and the text descriptive thereof of Blinn as allegedly teaching or suggesting the *wherein the at least one secondary product does not have a pre-established relationship with the primary product* portion of the above-quoted limitation. Final Office Action, pg. 18, fourth paragraph. Applicants have reviewed this cited portion of Blinn and are entirely at a loss as to how any reasonable equation could

be made between the clear description of a primary product that has no associated secondary product (and accordingly does not trigger any cross-selling in Blinn) and the claimed cross-selling *even when* the primary product is not associated with a secondary product.

Simply nowhere does Blinn appear to contemplate (much less provide actual written description of) offering secondary products where a primary product *does not* have a predetermined relationship with the a secondary product.

Accordingly, at least because Blinn fails to teach or suggest *dynamically determining a package on an ad hoc basis to be offered to the customer, the package comprising the primary product and at least one secondary product...wherein at least one of the at least one secondary product is selected for inclusion in the package based on an indication of past interest, by the customer, in at least one secondary product, and further wherein the at least one secondary product does not have a pre-established relationship with the primary product*, Blinn fails to render obvious any of claims **1-7, 12-43, 47-59, 61-72, 74-79, 82-104, and 108-126**.

Applicants therefore respectfully request that this §103(a) ground for rejection of claims **1-7, 12-43, 47-59, 61-72, 74-79, 82-104, and 108-126** be **withdrawn**.

**b) No Reason to Combine is Evident**

Even if the cited reference taught or suggested each limitation of claims **1-7, 12-43, 47-59, 61-72, 74-79, 82-104, and 108-126** (which Applicants maintain is not the case), the Examiner has failed to establish a *prima facie* case for obviousness for any of claims **1-7, 12-43, 47-59, 61-72, 74-79, 82-104, and 108-126**, at least because the Examiner has provided no valid argument, much less evidence (much less substantial evidence) that there would have been some reason for someone of ordinary skill in the art to modify the cited reference to read on the pending claims.

Accordingly, at least because the Examiner has (i) failed to show how every limitation of claims **1-7, 12-43, 47-59, 61-72, 74-79, 82-104, and 108-126** is taught or suggested, (ii) failed to provide a proper reason to modify the cited reference, and (iii)

failed to support any reason to modify by evidence on the record, the Examiner has failed to set forth a *prima facie* case for obviousness of claims **1-7, 12-43, 47-59, 61-72, 74-79, 82-104, and 108-126**.

Applicants therefore respectfully request that these §103(a) rejections of claims **1-7, 12-43, 47-59, 61-72, 74-79, 82-104, and 108-126** be **withdrawn**.

**c) No Factual Inquiries Resolved**

Applicants respectfully note that the factual inquiries that must be resolved to establish a *prima facie* case of obviousness, as set forth in *Graham v. John Deere*, may be summarized as follows: (i) determine the scope and content of the prior art; (ii) ascertain the differences between the prior art and the claims at issue; (iii) resolve the level of ordinary skill in the pertinent art; (iv) and consider objective evidence (*e.g.*, secondary considerations).

Applicants further respectfully note that the Examiner has provided no evidence in support of a *prima facie* case for obviousness, nor has the Examiner resolved any of the factual determinations required by *Graham v. John Deere*. Within such an evidentiary vacuum, the Examiner's unsupported conclusory statement that it would have been obvious to modify Blinn to achieve the claimed embodiments, is entirely meaningless.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness, and the §103(a) ground for rejection of claims **1-7, 12-43, 47-59, 61-72, 74-79, 82-104, and 108-126** should therefore be **withdrawn**.

**E. 35 U.S.C. §103(a) Rejections – Blinn, Gupta**

Claims **16-17** and **34-35** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Blinn in view of Gupta. Applicants respectfully assert that claims **16** and **34** are believed to be patentable at least for depending upon a patentable base claim (claim **1**) for the reasons described in relation thereto herein. Applicants also respectfully note that claims **17** and **35** have limitations substantially similar to those argued with respect to claim **1** herein, and are accordingly also believed patentable for the

reasons described in relation thereto herein. Applicants further assert that there is simply no evidence that Gupta makes up for any of the identified deficiencies of Blinn.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness, and the §103(a) ground for rejection of claims **16-17** and **34-35** should therefore be **withdrawn**.

**F. 35 U.S.C. §103(a) Rejections – Blinn, Tice**

Claims **55-56, 69-72, 114, and 118** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Blinn in view of Tice. Applicants respectfully note that independent claims **47** and **108** have limitations substantially similar to those argued with respect to claim **1** herein, and are accordingly also believed patentable for the reasons described in relation thereto herein. Applicants also respectfully assert that claims **55-56, 69-72, 114, and 118** are believed to be patentable at least for depending upon patentable base claims (claims **47** and **108**). Applicants further assert that there is simply no evidence that Tice makes up for any of the identified deficiencies of Blinn.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness, and the §103(a) ground for rejection of claims **55-56, 69-72, 114, and 118** should therefore be **withdrawn**.

**G. 35 U.S.C. §103(a) Rejections – Blinn, Bernard**

Claims **119-126** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Blinn in view of Bernard. Applicants respectfully traverse this ground for rejection as follows.

**1. No *Prima Facie* Case of Obviousness**

The Examiner has failed to show how every element of the claims is taught or suggested by the cited references and the Examiner has entirely failed to address or consider (much less resolve) any of the requisite factual inquiries as set forth in *Graham*

v. *John Deere*. The Examiner has further failed to set forth a valid reason that would have led one of ordinary skill in the art to combine and modify the cited references as suggested by the Examiner. At least for these reasons, as described in more detail hereinafter, the Examiner has failed to establish a *prima facie* case for obviousness.

**a) The reference fails to teach or suggest: *offering a package deal in response to a customer losing interest in an item* (claims 119-126; generally)**

Applicants respectfully assert that Blinn and Bernard, alone or in combination, fail to teach or suggest limitations of claims **119-126**. For example, Blinn and Bernard fail to teach or suggest *offering a package deal in response to a customer losing interest in an item*.

The Examiner admits that Blinn fails to teach the above-quoted limitation. Final Office Action, pg. 40, last paragraph. The Examiner goes on to allege that because Bernard discloses the capability of determining when a customer losses interest in a product, it merely would have been obvious to combine (and modify) Blinn and Bernard to teach the above-quoted limitation, because the limitation yields predictable results. *Id.*, at pg. 41, first two paragraphs.

Applicants respectfully note that the Examiner has provided **no evidence** that combining Blinn and Bernard, and then modifying the combination to achieve the claimed embodiments would indeed yield “predictable results”. Applicants further respectfully note that even under *KSR* there must be some evidence that the problem being solved was a problem recognized by one of ordinary skill in the art at the time of the invention – only then would predictable combinations of old elements be potentially “obvious”. The Examiner has provided no such evidence, and Applicants respectfully note that neither Blinn nor Bernard seems even remotely concerned with a customer’s loss of interest in products.

Accordingly, at least because Blinn and Bernard fail to teach or suggest *offering a package deal in response to a customer losing interest in an item*, Blinn and Bernard fail to render obvious any of claims **119-126**.



Applicants therefore respectfully request that this §103(a) ground for rejection of claims **119-126** be **withdrawn**.

**b) No Reason to Combine or Modify is Evident**

Even if the cited references taught or suggested each limitation of claims **119-126** (which Applicants maintain is not the case), the Examiner has failed to establish a *prima facie* case for obviousness for any of claims **119-126**, at least because the Examiner has provided no valid argument, much less evidence (much less substantial evidence) that there would have been some reason for someone of ordinary skill in the art to combine and modify the cited references to read on the pending claims.

Accordingly, at least because the Examiner has (i) failed to show how every limitation of claims **119-126** is taught or suggested, (ii) failed to provide a proper reason to combine and modify the cited references, and (iii) failed to support any reason to combine and/or modify by evidence on the record, the Examiner has failed to set forth a *prima facie* case for obviousness of claims **119-126**.

Applicants therefore respectfully request that these §103(a) rejections of claims **119-126** be **withdrawn**.

**c) No Factual Inquiries Resolved**

Applicants respectfully note that the factual inquiries that must be resolved to establish a *prima facie* case of obviousness, as set forth in *Graham v. John Deere*, may be summarized as follows: (i) determine the scope and content of the prior art; (ii) ascertain the differences between the prior art and the claims at issue; (iii) resolve the level of ordinary skill in the pertinent art; (iv) and consider objective evidence (*e.g.*, secondary considerations).

Applicants further respectfully note that the Examiner has provided no evidence in support of a *prima facie* case for obviousness, nor has the Examiner resolved any of the factual determinations required by *Graham v. John Deere*. Within such an evidentiary vacuum, the Examiner's unsupported conclusory statement that it would have been

obvious to combine Blinn and Bernard, *and then modify the combination* to achieve the claimed embodiments, is entirely meaningless.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness, and the §103(a) ground for rejection of claims **119-126** should therefore be **withdrawn**.

## **VI. Conclusion**

At least for the foregoing reasons, it is submitted that all pending claims are in condition for allowance, *or in better form for appeal*, and the Examiner's early re-examination and reconsideration are respectfully requested. Applicants' silence with respect to any comments made in the Final Office Action does not imply agreement with those comments.

Alternatively, if there remain any questions regarding the present application, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number (203) 438-6867 or via e-mail at cfincham@finchamdowns.com, upon the Examiner's convenience.

## **VII. Fees and Petition for Extension of Time to Respond**

Enclosed herewith is the appropriate **\$810.00** fee for filing of a Request for Continued Examination (RCE), for which this Amendment is an RCE Submission.

Applicants also hereby petition for a **four-month extension** of time and authorize the charge of **\$1,730.00** to Applicants' Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Submission, or credit any overpayment to Applicants' Deposit Account No. 50-0271.

Furthermore, should any other extension of time be required or any other fee be due, please grant any extension of time which may be required to make this Submission timely, and please charge any required fee to Applicants' Deposit Account No. 50-0271.

Respectfully submitted,

March 29, 2010  
Date

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